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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/727,793

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John Carney

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ATTORNEYS FOR CLIENT NUMBER 007412

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EXAMINER

SCHNURR, JOHN R

ART UNIT

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2421

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/727,793	<b>Applicant(s)</b> CARNEY ET AL.	
	<b>Examiner</b> JOHN SCHNURR	<b>Art Unit</b> 2421	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,6-17,22-33 and 38-53 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-17,22-33 and 38-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/25/2010 has been entered.

**DETAILED ACTION**

1. Claims 1, 6-17, 22-33 and 38-53 are pending and have been examined.

***Response to Arguments***

2. Applicant's arguments with respect to claims 1, 6-17, 22-33 and 38-53 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 17 and 22-32 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims require a computer program embodied on a "machine-readable medium." The broadest reasonable interpretation of a computer program embodied on a machine-readable medium in light of the specification includes a signal per se. As a signal is transitory in nature this creates a non-statutory transitory embodiment of the invention. Please refer to the

Art Unit: 2421

memorandum from David Kappos, dated 01/26/2010, entitled "Subject Matter Eligibility of Computer Readable Media."

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1, 6-8, 10, 12, 13, 15, 17, 22-24, 26, 28, 29, 31, 33, 38-40, 42, 44, 45, 48, 49 and 51-53** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shiels et al. (US 5,751,953)**, herein Shiels, in view of **Turner (US 2003/0009485)**.

Consider **claim 1**, Shiels clearly teaches a method comprising:

receiving input selecting a set of two or more of the plurality of video clips for presentation and a sequencing order, wherein the sequencing order is specified by a user-specified traversal of a decision tree having a plurality of decision nodes structured such that selecting a video clip at a first node constrains selection of video clips at a subsequent node; **(Fig. 6: At branch nodes A to G the user selects a video clip that constrains the selection of subsequent video clips, col. 5 lines 28-60.)**

However, Shiels does not explicitly teach:

providing one or more lists, each list containing a plurality of video clips;

creating, by a processor prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence; and

causing presentation of the composite video clip sequence.

In an analogous art, Turner, which discloses a system for providing a user defined composite media stream, clearly teaches:

Art Unit: 2421

providing one or more lists, each list containing a plurality of video clips;  
**(Fragments 11, [0091]-[0098])**

creating, by a processor prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence; and causing presentation of the composite video clip sequence. **(Figs. 2 and 3: A composite video clip is created from the plurality of fragments and played back on a user computer system, [0095]-[0105].)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Shiels by creating a composite video clip sequence prior to presentation, as taught by Turner, for the benefit of preventing distraction of the viewer during play back of the content (see [0008] Turner).

Consider **claim 6**, Shiels clearly teaches storing the composite video to a storage medium. **(Fig. 1 Local store 16)**

Consider **claim 7**, Shiels combined with Turner clearly teaches the storage medium is included in a digital video recorder. **(Fig. 3: Data storage device 105 Turner)**

Consider **claim 8**, Shiels clearly teaches causing presentation of the composite video clip sequence includes recognizing the completion of a component video clip and automatically commencing presentation of a subsequent component video clip. **(There is no discernable break in the video stream at the nodes, col. 5 lines 28-60.)**

9. (Previously Presented) The method of claim 8 wherein causing presentation of the composite video clip sequence includes initiating a new session for a component video clip prior to completion of presentation of a previous component video clip.

Consider **claim 10**, Shiels combined with Turner clearly teaches creating the composite video clip sequence includes creating a video file such that each component video clip is a segment of the video file. **(Fig. 6: The segments are combined into a video file based on the customization requirements of the user, Turner.)**

Art Unit: 2421

11. (Previously Presented) The method of claim 10 wherein transition between component video clips is accomplished by moving to specific time codes within the video file.

Consider **claim 12**, Shiels clearly teaches creating the composite video clip sequence includes concatenating each of the video clips of the selected set of two or more video clips. **(col. 5 lines 28-60)**

Consider **claim 13**, Shiels clearly teaches including component video clip metadata in or with the composite video clip. **(col. 3 lines 45-65)**

14. (Original) The method of claim 13 wherein the component clip metadata is a uniform resource locator.

Consider **claim 15**, Shiels clearly teaches inserting additional component video clips in the composite video clip sequence. **(Fig. 7)**

16. (Previously Presented) The method of claim 15 wherein the additional component video clips are automatically inserted in the composite video clip sequence based upon a set of predefined rules.

Consider **claim 17**, Shiels clearly teaches a machine-readable medium having stored thereon executable instructions which when executed by a processor cause a method to be performed, the method comprising:

receiving input selecting a set of two or more of the plurality of video clips for presentation and a sequencing order, wherein the sequencing order is specified by a user-specified traversal of a decision tree having a plurality of decision nodes structured such that selecting a video clip at a first node constrains selection of video clips at a subsequent node. **(Fig. 6: At branch nodes A to G the user selects a video clip that constrains the selection of subsequent video clips, col. 5 lines 28-60.)**

However, Shiels does not explicitly teach:

providing a list containing a plurality of video clips;

creating, prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence; and

causing presentation of the composite video clip sequence.

Art Unit: 2421

In an analogous art, Turner, which discloses a system for providing a user defined composite media stream, clearly teaches:

providing a list containing a plurality of video clips; (**Fragments 11, [0091]-[0098]**)

creating, prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence; and  
causing presentation of the composite video clip sequence. (**Figs. 2 and 3: A composite video clip is created from the plurality of fragments and played back on a user computer system, [0095]-[0105].**)

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Shiels by creating a composite video clip sequence prior to presentation, as taught by Turner, for the benefit of preventing distraction of the viewer during play back of the content (see [0008] Turner).

Consider **claim 22**, see claim 6.

Consider **claim 23**, see claim 7.

Consider **claim 24**, see claim 8.

Consider **claim 26**, see claim 10.

Consider **claim 28**, see claim 12.

Consider **claim 29**, see claim 13.

Consider **claim 31**, see claim 15.

Consider **claim 33**, Shiels clearly teaches system comprising:

a server configured to store video content, the video content including a plurality of video clips; (**Figs. 2-4: Data center 18, Cable server 26 or VOD server 30**) and

a user terminal communicatively coupled to the server, the user terminal comprising a processor and executable instructions which, when executed cause the user terminal to perform operations (**STB 14**) comprising:

providing access to the plurality of video clips,  
receiving a selection of a set of two or more video clips of the plurality of video clips for presentation,  
receiving input specifying a sequencing order for the set of selected video clips, wherein the sequencing order is specified by a user-specified traversal of a decision tree having a plurality of decision nodes structured

Art Unit: 2421

such that selecting a video clip at a first node constrains selection of video clips at a subsequent node, **(Fig. 6: At branch nodes A to G the user selects a video clip that constrains the selection of subsequent video clips, col. 5 lines 28-60.)**

However, Shiels does not explicitly teach:

creating, prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence, and

causing presentation of the composite video clip sequence.

In an analogous art, Turner, which discloses a system for providing a user defined composite media stream, clearly teaches:

creating, prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence, and  
causing presentation of the composite video clip sequence.

**(Figs. 2 and 3: A composite video clip is created from the plurality of fragments and played back on a user computer system, [0095]-[0105].)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Shiels by creating a composite video clip sequence prior to presentation, as taught by Turner, for the benefit of preventing distraction of the viewer during play back of the content (see [0008] Turner).

Consider **claim 38**, see claim 6.

Consider **claim 39**, see claim 7.

Consider **claim 40**, see claim 8.

Consider **claim 42**, see claim 10.

Consider **claim 44**, see claim 12.

Consider **claim 45**, see claim 13.

Consider **claim 48**, Shiels clearly teaches an apparatus comprising:

a processor; and



Art Unit: 2421

a machine-readable medium having stored thereon executable instructions which, when executed, cause the apparatus at least to perform: **(Fig. 5)**

receiving input selecting a set of two or more of the plurality of the video clips for presentation and a sequencing order, wherein the sequencing order is specified by a user-specified traversal of a decision tree having a plurality of decision nodes structured such that selecting a video clip at a first node constrains selection of the video clips at a subsequent node; **(Fig. 6: At branch nodes A to G the user selects a video clip that constrains the selection of subsequent video clips, col. 5 lines 28-60.)**

However, Shiels does not explicitly teach:

providing one or more lists, each list containing a plurality of video clips;

creating, prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence; and causing presentation of the composite video clip sequence.

In an analogous art, Turner, which discloses a system for providing a user defined composite media stream, clearly teaches:

providing one or more lists, each list containing a plurality of video clips; **(Fragments 11, [0091]-[0098])**

creating, prior to presentation, a composite video clip sequence comprising the set of the two or more of the plurality of video clips in the sequencing order, wherein each of the video clips is a component video clip of the composite video clip sequence; and causing presentation of the composite video clip sequence. **(Figs. 2 and 3: A composite video clip is created from the plurality of fragments and played back on a user computer system, [0095]-[0105].)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Shiels by creating a composite video clip sequence prior to presentation, as taught by Turner, for the

Art Unit: 2421

benefit of preventing distraction of the viewer during play back of the content (see [0008] Turner).

Consider **claim 49**, see claim 8.

Consider **claim 51**, see claim 12.

Consider **claim 52**, see claim 13.

Consider **claim 53**, see claim 15.

7. Claims **9, 11, 16, 25, 27, 32, 41, 43, 47 and 50** are rejected under 35 U.S.C.

103(a) as being unpatentable over **Shiels et al. (US 5,751,953)** in view of **Turner (US 2003/0009485)** further in view of **Begeja et al. (US 2003/0030752)**, herein Begeja.

Consider **claim 9**, Shiels combined with Turner clearly teaches providing a composite video clip sequence on demand.

However, Shiels combined with Turner does not explicitly teach presenting the composite video clip sequence includes initiating a new session for a component video clip prior to completion of presentation of a previous component video clip.

In an analogous art, Begeja, which discloses a system for video streaming, clearly teaches presenting the composite video clip sequence includes initiating a new session for a component video clip prior to completion of presentation of a previous component video clip. **(While previously obtained and locally stored information is being played a second media stream is being delivered and/or buffered for viewing, [0086] Begeja.)**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Shiels combined with Turner by initiating a new session for a component video clip prior to completion of presentation of a previous component video clip, as taught by Begeja, for the benefit of starting playback of the video stream more quickly.

Consider **claim 11**, Shiels combined with Turner and Begeja clearly teaches transition between component video clips is accomplished by moving to specific time codes within the video file. **(The player identifies the clip based on the start time timestamp, [0046] and [0053] Begeja.)**

Consider **claim 16**, Shiels combined with Turner and Begeja clearly teaches the additional component video clips are automatically inserted in the composite video clip sequence based upon a set of predefined rules. **(The commercials are inserted between every third clip, [0057] Begeja.)**

Art Unit: 2421

Consider **claim 25**, see claim 9.  
Consider **claim 27**, see claim 11.  
Consider **claim 32**, see claim 16.  
Consider **claim 41**, see claim 9.  
Consider **claim 43**, see claim 11.  
Consider **claim 47**, see claim 16.  
Consider **claim 50**, see claim 9.

8. Claims **14, 30 and 46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Shiels et al. (US 5,751,953)** in view of **Turner (US 2003/0009485)** in view of **Begeja et al. (US 2003/0030752)** further in view of **Mitchell (US 2002/0162120)**.

Consider **claim 14**, Shiels combined with Turner and Begeja clearly teaches including component metadata.

However, Shiels combined with Turner and Begeja does not explicitly teach the metadata is a uniform resource locator.

In an analogous art Mitchell, which discloses a system for transferring video information, clearly teaches transmitting metadata using URLs. **([0064])**

Therefore, at the time the invention was made, it would have been obvious to one with ordinary skill in the art to modify the system of Shiels combined with Turner and Begeja by transmitting the metadata using URLs, as taught by Mitchell, for the benefit of enabling the STB to access the Internet ([0003] Mitchell).

Consider **claim 30**, see claim 14.  
Consider **claim 46**, see claim 14.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN SCHNURR whose telephone number is (571)270-1458. The examiner can normally be reached on M-F 9a-5p.

Art Unit: 2421

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

JRS

Application/Control Number: 10/727,793  
Art Unit: 2421

Page 12